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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/634,627
Filing Date: August 05, 2003
Appellant(s): ROBERTSON, STEVEN C.

MAILED

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GROUP 3600

Patrick Michael Dwyer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 15, 2007 appealing from the Office action mailed January 31, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Appellant describes claims 29-37 and 39-47 as rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen in view of official notice. In fact, claims 29, 32, and 46 stand as rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen in view of official notice. Claims 30, 31, 33-37, 39-45, and 47 are rejected as unpatentable over Cohen in view of official notice and

a multiplicity of explicit references. Claim 38 is objected to as depending on a rejected claim, but potentially allowable.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|-----------------|---------|
| 5,884,309 | Vanechanos, Jr. | 03-1999 |
| 5,970,474 | LeRoy et al. | 10-1999 |
| 5,963,948 | Shilcrat | 10-1999 |

Cohen, E., "Going to the Chapel," PC Magazine, Vol. 17, No. 12, p. 40 (June 30, 1998).

Anon., "InfoGear(R) and Amazon.com Team Up to Sell Books Via Internet Appliances," PR Newswire (March 10, 1998).

Anon., "Lillian Vernon Launches New Interactive Online Catalog," PR Newswire (December 2, 1998).

Lewis, D., "Desk: Zydcor's Septet of Applications Takes Aim at Microsoft Works," MacUser, Vol. 7, No. 1, p. 74 (January 1991).

Snyder, B., "Stores battle Publishers for Online Gift Registries," Advertising Age, Vol. 69, No. 11, p. 34 (March 16, 1998).

Microsoft Press Computer Dictionary, Third Edition, Microsoft Press, Redmond, 1997, p. 27.

(9) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-37 and 39-45

Claims 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") in view of official notice. As per claim 29, Cohen discloses a method of providing a gift registry service over a distributed network of computers, the method comprising the following steps: (b) a gift registrant accessing goods or services online from a plurality of goods or service provider (SP) sites, and registering a gift selection from one or more, potentially each, of the plurality of goods or service provider sites into a gift registrant wish list; (c) storing the wish list into a wish list data memory structure accessible to at least one gift registry site; and (d) a gift purchaser accessing the stored wish list from a site on the distributed network (first three paragraphs). Cohen does not expressly disclose (a) running a gift registrar application on at least one gift registry site, but official notice is taken that running applications on computers is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to run a gift registrar application on at least one gift registry site, for the obvious advantage of enabling the online sites disclosed by Cohen to carry out their disclosed functions.

Cohen does not expressly disclose that the gift purchaser accesses the stored wish list from a site remote from any gift registry sites, but official notice is taken that it is well known to access online web sites from remote sites, that being one of the beauties of the World Wide Web. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the access to be remote, for the stated advantage of not having to trudge around crowded department stores and wait in line to buy gifts on a couple's wedding registry.

As per claim 32, Cohen discloses a "couple's personalized 'Our Wedding' page" (second paragraph), implying that the gift registrant has registered an occasion and associated at least one wish list with the occasion, the occasion data and the association(s) being stored in an occasion data memory structure accessible to the gift registry site. Cohen does not disclose whether the gift registrant has registered an occasion before or after (b) accessing goods or services online from provider sites, and registering gift selections. The result would be the same in either case, and even if the order differs from that in the system Cohen describes, changing the sequence in which ingredients are added has been held to be obvious to one of ordinary skill (*Ex Parte Rubin* 128 USPQ 440, 441-442, Board of Patent Appeals and Interferences, 1959), to which a change in the sequence in which steps are performed with the same results is held to be analogous.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") and official notice as applied to claim 29 above, and further in view of the anonymous article, "InfoGear® and Amazon.com Team up to Sell Books Via

Internet Appliances,” hereinafter “InfoGear.” Cohen does not disclose that the gift purchaser accesses the wish list by searching for at least one criterion, but it is well known to access relevant pages, etc., by searching websites by at least one criterion, as taught, for example, by “InfoGear” (paragraph beginning, “The CIDCO iPhone’s touch-screen,” and in particular the sentences beginning, “The extensive Amazon.com website” and “Other features include”). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention for the gift purchaser to access the wish list by searching for at least one criterion (e.g., searching through a list of couples to find the name(s) of the gift registrant(s), or else entering a criterion such as the gift registrant’s name in an engine for searching a gift registry site), for the obvious advantage of enabling a gift purchaser to find the wish list on a site where there a multiplicity of wish lists.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (“Going to the Chapel”) and official notice as applied to claim 29 above, and further in view of the anonymous article, “Lillian Vernon Launches New Interactive Online Catalog,” hereinafter “Lillian Vernon.” Cohen does not disclose (e) the gift registrant creating a distribution list, the distribution list being stored in a distribution list memory data structure from the gift registry site; (f) the gift registrant requesting that the gift registrar application send notifications to members of the distribution list; and (g) the gift registrar sending notifications to members of the distribution list. However, “Lillian Vernon” teaches a distribution list, evidently stored in a corresponding data structure for the disclosed features to be operative, the gift registrar sending notifications to

members of the distribution list, wherein the distribution list is presumably created by the gift registrant, who also requests that notifications be sent to members of the distribution list (paragraph beginning, "Features of the new online catalog"), because otherwise it would be difficult for the gift registrar to know who the customer's "family and friends" were, what their e-mail addresses were, or what dates were special occasions; also, sending such reminders without the approval of the gift registrant could lead to embarrassment and various difficulties. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to carry out these steps, for the obvious and implied advantages of aiding gift registrants in obtaining the products they desire, and sellers in making profitable sales.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") and official notice as applied to claim 32 above, and further in view of the anonymous article, "Lillian Vernon Launches New Interactive Online Catalog," hereinafter "Lillian Vernon." Claim 33 is obvious on the grounds set forth for claim 31 above.

Claims 34, 35, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel"), "Lillian Vernon," and official notice as applied to claim 33 above, and further in view of Lewis ("Desk: Zedcor's Septet of Applications Takes Aim at Microsoft Works"). As per claim 34, "Lillian Vernon" teaches sending reminders before special occasions such as birthdays, anniversaries, and holidays (paragraph beginning, "Features of the new online catalog"), implying the gift registrant specifying an occasion reminder which is stored. "Lillian Vernon" does not

disclose the gift registrant specifying an occasion reminder for repeating notifications, but it is well known to specify how an occasion reminder is to be repeated, as taught by Lewis (paragraph beginning, "Appointments. DeskSecretary reminds you"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift registrant to specify an occasion reminder for repeating notifications, the occasion reminder being stored in a memory structure, for the obvious advantage of arranging repeated notifications, increasing the chance that a potential gift purchaser will remember to purchase a gift.

As per claim 35, "Lillian Vernon" teaches a wish list associated to the occasion reminder, implying storing the association is a suitable memory, for the disclosed operations to be carried out (paragraph beginning, "Features of the new online catalog"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to associate a wish list to the occasion reminder, for the obvious and implied advantage of causing family and friends to purchase a wished-for item.

As per claim 36, neither Cohen nor "Lillian Vernon" expressly discloses associating an SP (merchant) site to the occasion reminder, but official notice is taken that it is well known for e-mails to include merchant or other site links associated to them. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to associate an SP (merchant) site to the occasion reminder, for the obvious advantage of encouraging potential gift purchasers to connect to a site where gifts can be purchased.

As per claim 37, "Lillian Vernon" teaches at least one occasion trigger, presumably specified by the gift registrant, for notification of the members of an associated distribution list (friends and family notified of an approaching birthday, anniversary, or holiday; paragraph beginning, "Features of the new online catalog"); further, the gift registrar automatically sends the occasion reminder to each of the members on the tripping of an occasion trigger (the trigger being that it is three weeks before the special occasion). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to carry this out, for the obvious and implied advantage of causing members of the distribution list to make purchases.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") and official notice as applied to claim 29 above, and further in view of Snyder ("Stores Battle Publishers for Online Gift Registries"). Cohen does not disclose an SP registering a sale event by sending sale event data over the network of computers to the gift registry site, the gift registry site storing the data, but Snyder teaches gift registries selling advertising on their sites (paragraph beginning, "For the online content sites"), and official notice is taken that it is well known to transmit advertising data to the site where the advertising will be posted, and also that it is well known for advertising data to comprise sale event data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for an SP to register a sale event by sending advertisement data over the network of computers to the gift registry, the gift registry site storing the data,

for the obvious advantage of enabling advertising of a sale event to be displayed on the gift registry site, and the gift registry site to profit from selling advertising, as stated in Snyder.

Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel"), Snyder ("Stores Battle Publishers for Online Gift Registries") and official notice as applied to claim 39 above, and further in view of the anonymous article, "Lillian Vernon Launches New Interactive Online Catalog," hereinafter "Lillian Vernon." As per claim 40, selling advertising on a site with demographically desirable shoppers, as taught by Snyder, implies displaying the advertising, which may include sale event data, as set forth above with regard to claim 39, on the site; "Lillian Vernon" teaches a gift registrar sending out notifications (paragraph beginning, "Features of the new online catalog"), and official notice is taken that it is well known to send out notifications (e.g., e-mails) containing advertising. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift registrar to send out a sale event notification, for the obvious advantage of notifying potential purchasers of a sale event, making them more likely to buy.

As per claim 41, "Lillian Vernon" teaches a gift registrar sending out notifications with pertinent wish list data.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") and official notice as applied to claim 29 above, and further in view of Vanechanos, Jr. (U.S. Patent 5,884,309). Cohen does not disclose, after step

(d), the gift purchaser viewing a display of multiple SP's from whom the purchaser may purchase items on the gift registrant's wish list, but it is well known to display multiple merchant sites from which a purchaser may purchase items, as taught by Vanechanos (column 6, line 63, through column 7, line 15). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift purchaser viewing a display of multiple SP's, for the obvious advantage of enabling the gift purchaser to select a suitable of preferred SP.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") and official notice as applied to claim 29 above, and further in view of Shilcrat (U.S. Patent 5,963,948). Cohen does not disclose, after step (d), the gift registrar application indicating the most desirable SP for an item on the gift registrant's wish list, but it is well known for cybermalls to enable users to search across multiple merchant sites to find the merchant offering desired products, or offering them cheaply, as taught, for example, by Shilcrat (column 2, lines 2-10), and providing such information is held to constitute indicating the most desirable merchant site/SP. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift registrar application to indicate the most desirable SP for an item on the gift registrant's wish list, for the obvious advantage of assisting purchasers in finding desired products, and finding them cheaply, etc., thus encouraging use of the gift registrar site.

Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") and official notice as applied to claim 29 above, and

further in view of LeRoy et al. (U.S. Patent 5,970,474). As per claim 44, Cohen discloses (l) the gift purchaser purchasing a gift suggested by the gift registrant's wish list (first three paragraphs). Cohen does not disclose (m) the gift registrar application storing data pertaining to the gift purchaser's purchases for a gift registrant in a purchased items data memory structure accessible to the gift registry site, but it is well known to store purchase information regarding a gift registrant in accessible memory, as taught by LeRoy (column 6, lines 59-68; column 8, lines 11-50). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to thus store the purchase information, for the stated advantage of updating a gift registry, and ensuring that the latest information is always provided to a purchasing customer desiring to purchase a gift for the registrant (e.g. avoiding duplicate presents).

As per claim 45, LeRoy teaches providing gift recommendations to prospective gift purchasers, based upon gifts previously purchased for gift registrant whose wish list the purchaser is accessing (just as above, regarding claim 44).

Claim 46

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") in view of official notice. Cohen discloses a method of providing a gift registry service over a distributed network of computers, the method comprising the following steps: (b) a gift registrant accessing goods or services online from a goods or service provider (SP) site, and registering a gift selection from the goods or service

provider site into a gift registrant wish list; (c) storing the wish list into a wish list data memory structure accessible to at least one gift registry site; and (d) a gift purchaser accessing the stored wish list from a site on the distributed network (first three paragraphs). Cohen does not expressly disclose (a) running a gift registrar application on at least one gift registry site, but official notice is taken that running applications on computers is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to run a gift registrar application on at least one gift registry site, for the obvious advantage of enabling the online sites disclosed by Cohen to carry out their disclosed functions.

Cohen does not expressly disclose that the gift purchaser accesses the stored wish list from a site remote from any gift registry sites, but official notice is taken that it is well known to access online web sites from remote sites, that being one of the beauties of the World Wide Web. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the access to be remote, for the stated advantage of not having to trudge around crowded department stores and wait in line to buy gifts on a couple's wedding registry.

Claim 47

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") in view of Shilcrat (U.S. Patent 5,963,948) and official notice. Cohen discloses a method of providing a gift registry service over a distributed network of computers, the method comprising the following steps: (b) a gift registrant accessing

goods or services online from a plurality of goods or service provider (SP) sites, and registering a gift selection from one or more, potentially each, of the plurality of goods or service provider sites into a gift registrant wish list; (c) storing the wish list into a wish list data memory structure accessible to at least one gift registry site; and (d) a gift purchaser accessing the stored wish list from a site on the distributed network (first three paragraphs). Cohen does not expressly disclose (a) running a gift registrar application on at least one gift registry site, but official notice is taken that running applications on computers is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to run a gift registrar application on at least one gift registry site, for the obvious advantage of enabling the online sites disclosed by Cohen to carry out their disclosed functions.

Cohen does not expressly disclose that the gift purchaser accesses the stored wish list from a site remote from any gift registry sites, but official notice is taken that it is well known to access online web sites from remote sites, that being one of the beauties of the World Wide Web. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the access to be remote, for the stated advantage of not having to trudge around crowded department stores and wait in line to buy gifts on a couple's wedding registry.

Cohen does not disclose the gift registrar application indicating to the gift purchaser the most desirable SP for an item on the gift registrant's wish list, but it is well known for cybermalls to enable users to search across multiple merchant sites to find the merchant offering desired products, or offering them cheaply, as taught, for

example, by Shilcrat (column 2, lines 2-10), and providing such information is held to constitute indicating the most desirable merchant site/SP. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift registrar application to indicate the most desirable SP for an item on the gift registrant's wish list, for the obvious advantage of assisting purchasers in finding desired products, and finding them cheaply, etc., thus encouraging use of the gift registrar site.

Allowable Subject Matter

Claim 38 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Cohen ("Going to the Chapel"), teaches a method of providing a gift registry service over a distributed network of computers, with many elements of claim 29. Other elements of claim 29 and its dependents, through claim 37, are taught by the anonymous article, "Lillian Vernon Launches New Interactive Online Catalog," by Lewis ("Desk: Zedcor's Septet of Applications Takes Aim at Microsoft Works"), or are officially noticed as being well known, as set forth above. However, neither Cohen nor any other prior art of record discloses after automatically sending an occasion reminder to the members of an associated distribution list (e.g., friends and family of a gift registrant), a gift registrar application automatically sending

an occasion notification to at least one SP (service provider, such as a merchant selling products to be given as wedding or birthday gifts) upon the tripping of an occasion trigger. It is known to take various actions upon tripping of an occasion trigger, and it is known to send data to merchants (e.g., demographic data on persons to whom the merchants may wish to advertise), but that is not specific enough to make sending such occasion notifications to at least one SP obvious, particularly not in the context of a gift registry service.

Although reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention (*In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991)), the factor that a finding of obviousness against claim 38 based on a reference regarding transmitting data to merchants would have to be combined with three explicit references and several facts of which official notice was taken further weighs against finding claim 38 obvious.

(10) Response to Argument

The primary question is whether Examiner's taking of official notice was proper and permissible, leading to the correct conclusion that the claims were obvious, or, as Appellant argues, improper and impermissible. Examiner maintains that official notice was taken only of obvious and well-known facts, capable of instant and unquestionable demonstration, and that the conclusions of obviousness made on that basis were entirely justified.

Appellant quotes a paragraph from the MPEP, Section 2144.03(A), stating:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.

Appellant has not seen fit to quote the immediately preceding paragraph of the MPEP, which states that in some circumstances, taking official notice is proper, "where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." (Emphasis added.) The case of *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) is cited as precedent for a court upholding a taking of notice of an obvious and well-known fact, as are *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973), and *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Appellant has also left unquoted Section 2144.03(C), where the MPEP states that to adequately traverse a taking of official notice, an applicant must specifically point out the supposed errors in the examiner's action, and provides, "If applicant does not traverse the examiner's taking of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because

applicant either filed to traverse the examiner's assertion of official notice or that the traverse was inadequate."

This is very relevant to the present case, because in the first Office action mailed July 20, 2006, Examiner took official notice of various points which he considered to be well-known, and capable of swift and unquestionable demonstration. In the remarks filed December 26, 2006, Applicant (now Appellant) traversed and challenged Examiner's taking of official notice regarding one and only one of these points, the assertion, made in regard to claim 30, that it is well known to access relevant pages, etc., by searching websites by at least one criterion. In response, Examiner made of record the "InfoGear" article, using it to support the rejection of claim 30 in the Office action mailed January 31, 2007, and wrote in that Office action (page 17):

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice, except with regard to claim 30. In response to Applicant's traversal, Examiner has relied upon explicit prior art to meet the limitation of claim 30.

Therefore, Appellant's current traversal of Examiner's taking of official notice is not timely, and does not require any documentation to support the well-known facts of which official notice was taken.

Regarding specifics, Examiner relied upon Cohen's article describing several online gift registries to reject claim 29, taking official notice that running applications on

computers is well known, and that it is well known to access online web sites from remote sites. Contrary to what Appellant implies (page 7 of the Appeal Brief), Examiner did not take official notice that it was well known to run a gift registrar application on at least one gift registry site. That was a conclusion based on Cohen and on the general well-known character of applications, as supported by the Microsoft Press Computer Dictionary's definition of "application." It is not clear how the servers for the gift registry websites disclosed by Cohen could operate without running programs describable as gift registrar applications, and even if they possibly could and did, application programs are such standard features of computers that their use would have been obvious.

Regarding Appellant's point about dates, Examiner replies that "official notice is taken that it is well known" is the conventional phrase, used to keep Office actions from being even more lengthy and legalistic than they already are, and that the proper test is whether something was well known at the time of Appellant's priority date (May 7, 1999). This was implicitly acknowledged by Examiner's statement in the Office action of January 31, 2007, "running applications is very well known, and was even in 1999." Furthermore, "InfoGear" and the Microsoft Press Computer Dictionary (third edition) were both published before Applicant's priority date, and chosen on that basis (as were the other prior art references applied). Every fact of which official notice was taken is believed not only to be well-known now, but to have been well-known before May of 1999, and official notice was taken with that understanding.

Appellant further argues (page 9 of the Appeal Brief) that Examiner's taking of official notice in the rejection of claim 36 that it is well known for e-mails to include

merchant or other site links associated to them was improper, based again on dates.

Next, Appellant makes a similar argument regarding claims 40 and 41, where Examiner took official notice that it is well known to send out notifications (e.g., e-mails) containing advertising. As the issues are essentially the same as before, Examiner reiterates that every fact of which official notice was taken is held to have been well-known before May of 1999, and official notice was taken with that understanding.

Appellant accuses Examiner of having misinterpreted a traversal of Examiner's rejection of claim 29, made in the Amendment and Response mailed December 20, 2006 (filed December 26), and failing to provide required documentation to support the taking of official notice in claim 29. Examiner replies that page 10 of that Amendment and Response clearly states that Appellant traversed the rejection. It does not say that Appellant traversed the taking of official notice, or call for documentation that running applications on computers was well known. Therefore, Examiner was under no obligation to document this fact, even though Examiner actually did make a page from the 1997 edition of the Microsoft Press Computer Dictionary of record to show that computer applications had been well known before Appellant's priority date. Examiner may perhaps have misinterpreted Appellant's intention, but is entirely confident that he did not misinterpret Appellant's written words.

On page 11 of the Appeal Brief, Appellant disputes Examiner's conclusion that running a gift registrar application would have been obvious, based on Cohen and the well-known existence of computer applications. Appellant writes, "[Examiner] might as have taken notice, in say a claim involving a jelly donut, that baked goods were well

known.” Examiner replies that this is a false analogy, because donuts are usually fried rather than baked. More importantly, and in contrast to Appellant’s assertions, Cohen explicitly discloses several online gift registries.

Appellant attempts to dismiss as unsupported speculation Examiner’s statement that he could not imagine how else (without a computer application) such sites must operate. Examiner replies that Appellant gives no example of websites and their servers operating without computer applications for carrying out their functions, and furthermore, what Examiner actually wrote (page 15 of the Office action mailed January 31, 2007) was, “It is not clear how the servers for the gift registry websites disclosed by Cohen could operate without running programs describable as gift registrar applications, and even if they could and did, application programs are such standard features of computers that their use would have been obvious.” Even if some source somewhere could be found to prove that both Examiner and Appellant had suffered a failure of knowledge and imagination, and gift registry web sites could somehow operate without gift registry applications, that alternative to applications would not make such applications non-obvious.

On page 12 of the Appeal Brief, Appellant argues that Cohen actually teaches away from element (b) of claim 29, “a gift registrant accessing goods or services online from a plurality of goods or service provider (SP) sites.” Examiner replies that this is in error, as witness the sentence from Cohen, “Couples select items from a list of online retailers.”

On pages 13 and 14, Applicant traverses the rejection of claim 30, but does not actually address the obviousness of the limitation of claim 30 (based on the "InfoGear" article); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 14, 15, and 16, Appellant traverses the rejection of claim 31, but does not actually address the obviousness of the limitation of claim 31 (based on the "Lillian Vernon" article); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies.

On pages 16, 17, and 18, Appellant disputes the rejection of claim 32, but without actually addressing the obviousness of the limitation of claim 32 (rejected based on Cohen and official notice, without any secondary reference, or official notice of any fact not used in rejecting claim 29). Examiner reiterates his arguments for the obviousness of claim 29.

On pages 18, 19, and 20, Appellant traverses the rejection of claim 33, but does not actually address the obviousness of the limitation of claim 33 (based on the "Lillian Vernon" article); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 20, 21, and 22, Appellant traverses the rejection of claim 34, but does not actually address the obviousness of the limitation of claim 34 (based on the "Lillian Vernon" article, and the article by Lewis); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 22 and 23, Appellant traverses the rejection of claim 35, but does not actually address the obviousness of the limitation of claim 35 (based on the "Lillian Vernon" article); instead Appellant reiterates his arguments against the

obviousness of claim 29. Examiner reiterates his replies. On pages 24 and 25, Appellant traverses the rejection of claim 36, but does not actually address the obviousness of the limitation of claim 36 (based on official notice that it is well known for emails to include merchant or other site links associated to them); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 25, 26, and 27, Appellant traverses the rejection of claim 37, but does not actually address the obviousness of the limitation of claim 37 (based on the "Lillian Vernon" article); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies.

On pages 27, 28, and 29, Appellant traverses a supposed rejection of claim 38, by reiterating his arguments against the obviousness of claim 29. Examiner replies that there is no actual rejection of claim 38, which was found potentially allowable, although objected to as depending from rejected claim 29. Examiner reiterates his replies regarding claim 29, although only as an explanation of why claim 38 was objected to rather than allowed outright.

On pages 29, 30, and 31, Appellant traverses the rejection of claim 39, but does not actually address the obviousness of the limitations of claim 39 (based on the article by Snyder, and further official notice); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 31, 32, and 33, Appellant traverses the rejection of claim 40, but does not actually address the obviousness of the limitations of claim 40 (based on the article by Snyder, the "Lillian Vernon" article, and further official notice); instead Appellant reiterates his arguments

against the obviousness of claim 29. Examiner reiterates his replies. On pages 33 and 34, Appellant traverses the rejection of claim 41, but does not actually address the obviousness of the limitation of claim 41 (based on the "Lillian Vernon" article); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 35 and 36, Appellant traverses the rejection of claim 42, but does not actually address the obviousness of the limitation of claim 42 (based on Vanechanos, U.S. Patent 5,884,309); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 36, 37, and 38, Appellant traverses the rejection of claim 43, but does not actually address the obviousness of the limitation of claim 43 (based on Shilcrat, U.S. Patent 5,963,948); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 38, 39, and 40, Appellant traverses the rejection of claim 44, but does not actually address the obviousness of the limitations of claim 44 (based on LeRoy, U.S. Patent 5,970,474); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies. On pages 40, 41, and 42, Appellant traverses the rejection of claim 45, but does not actually address the obviousness of the limitations of claim 45 (based on LeRoy, U.S. Patent 5,970,474); instead Appellant reiterates his arguments against the obviousness of claim 29. Examiner reiterates his replies.

On pages 42, 43, and 44, Appellant traverses the rejection of claim 46, repeating the arguments made against the rejection of claim 29. Examiner replies that claim 46 is properly rejected on the same grounds as closely parallel claim 29.

On pages 44, 45, and 46, Appellant traverses the rejection of claim 47, repeating the arguments made against the rejection of claim 29, and, incidentally, stating, "Claim 47 stands rejected based solely on the Cohen reference combined with 'official notice.'" Examiner notes that this is not the case: claim 47 recites a step (e) which lacks parallel in claim 29, and because of this, claim 47 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen ("Going to the Chapel") in view of Shilcrat (U.S. Patent 5,963,948) and official notice. However, because Appellant does not refer to step (e) nor make any argument against the applicability of Shilcrat, Examiner has no new arguments to rebut, but merely reiterates his replies defending the rejection of claim 29, and refers interested parties to the rejection of claim 47 set forth above.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Nicholas D. Rosen


NICHOLAS D. ROSEN
PRIMARY EXAMINER

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